

Name of the country – not descriptive or misleading

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The major shoes retailer UAB “Danbalt International” sought to register trademark DANIJA (in Eng. – DENMARK) for marking of shoes retail services in class 35. The examiner of the Office has refused registration of the mark stating that it simply designates the country of origin as constitutes only of the name of the country, on the other hand it can mislead the public as to the geographical origin of goods.

The applicant has appealed the decision and obtained positive result – the Board of Appeals by the decision No. 2Ap-1599 of 30 April, 2014 has overruled the initial decision.

The Board came to the conclusion that the geographical name “DANIJA” in the mind of the consumers not exceptionally associated with place of the production of shoes, moreover – with special place of the sales of shoes, related to the special quality of goods or services, therefore it will be treated as invented name. In such case it is not acceptable to refuse trademark registration automatically, without evaluating the relation between geographical name comprising the mark and goods or services covered by the mark.

The Board has also decided that the mark “DANIJA” is not misleading or deceptive, also it does not designate directly misleading information. In this case it is necessary to evaluate the market situation, habits of the consumers, the perception of the part of the public. The evidences filed by the applicant proved that the mark “DANIJA” was used and advertised for a long period of time, the applicant did not state that goods or services covered by the mark originate from Denmark. The applicant's position has been supported by the public opinion survey – the major part of the interviewed evaluate the sign “DANIJA” as a trademark, used for marking of shoe shops.

Such decision not simply confirmed the legitimacy of granting exclusive rights to name of the country as a trademark of the major market player, but also opened possibility for the others to obtain trademark protection rather than automatic refusal of the application.

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